



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885
26807	7590	02/06/2007		
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			EXAMINER GOLLAMUDI, SHARMILA S	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 02/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 64, 66, 68, 73, 78 and 81-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 64, 66, 68, 73, 78 and 81-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1616

DETAILED ACTION

Receipt of Amendments/Remarks filed 10/20/06 and Supplemental Amendments filed 10/26/06 is acknowledged. Receipt of the Rule 132 Declaration filed 10/20/06 is acknowledged. Claims 61, 64, 66, 68, 73, 78, 81-88 are pending in this application. Claims 1-60, 62-63, 65, 67, 69-72, 74-77, and 79-80 stand cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 61-66 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strella et al (3,928,656) in view of Ohno (5854365) is withdrawn in view of the amendments of 10/20/06 since Strella does not teach the instant solvents claimed.

Claims 61, 64, 66, 68, 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) in view of Strella (3,928,656).

Perronin teaches the preparation of pigmentary particles coated with an organic polymer

Art Unit: 1616

to allow dispersible of the pigment in a medium.. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, textiles, and cosmetics. Note column 1, lines 10-12. Perronin teaches the pigment composition may be advantageously used in numerous fields of application, such as the pigmentation of collodions for spinning, inks, plastics materials, paints, creams or other colored preparations. See column 4, lines 45-55. Perronin teaches examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. see column 3, lines 40-60. Perronin teaches the pigments used in the composition may be mineral or organic pigments. Perronin teaches iron oxides, cadmium oranges, chrome yellows, molybdenum red and titanium dioxide as examples of mineral pigments. The organic pigments may belong to a variety of classes such as azo, azomethine, anthraquinone, phthalocyanine or indigoids. See column 2, line 65 to column 3, line 5. The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, 1-methyl-ethanol, n-butanol, 2-methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan. See column 2, lines 45-61.

Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% 90/10 copolymer of MMA-AA), 50%

Art Unit: 1616

nitrocellulose resin in butyl acetate in 86 parts, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Note that nitrocellulose is in the amount of about 6.2% of the total composition; the pigment is in the amount of 13.7%, and the copolymer in the amount of 13.7%.

Although Perronin teaches that the monomers may be selected from several monomer including butyl and methyl esters of methacrylic acid, Perronin does not expressly teach the instantly claimed butyl methacrylate-acrylic acid copolymer.

Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. Strella teaches preparing a colored toner for forming a uniform dispersion of dye or pigment in a resinous material. The polymers taught include butyl methacrylate-acrylic acid, for providing toner compositions. See column 6, lines 15-30 and examples. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%). See example 1, column 9. The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8). See examples II. The examiner utilizes this intermediate composition to reject the claims. The examiner utilizes this intermediate composition to reject the claims. Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20%. See column 6, lines 4-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look at Strella and utilize the instantly claimed copolymer. Strella demonstrates the prior art wherein it is known to utilize the instant copolymer to coat a pigment for dispersal in a

Art Unit: 1616

solvent. Therefore, a skilled artisan would have been motivated to look to Strella and utilize the instant copolymer with the expectation of similar results since Strella teaches butyl methacrylate-acrylic acid copolymer as a suitable polymer to coat pigments and Perronin suggests the use of several monomers including esters of methacrylic acids wherein the alkyl may be butyl to coat the pigment.

With regard to the preamble, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With regard to the functional limitations, it is the examiner's position that Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar.

With regard to claim 82, Perronin teaches 6.2% nitrocellulose and not instantly claimed 0.5-5%. However, it would have been obvious to a skilled artisan to manipulate this concentration during routine optimization and experimentation. It should be noted that generally difference in concentrations do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such as concentration is critical. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Art Unit: 1616

With regard to the copolymer molecular weight, the substitution of methyl for butyl will provide a molecular weight of about 68,000. The examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000.

Response to Arguments and Rule 132 Declaration

Applicant argues that Perronin et al discloses the use of a polymer comprising 90% methyl methacrylate (MMA/AA) and 10% acrylic acid and thus Perronin fails to suggest or teaches the instant butyl methacrylate/acrylic acid (BMA/AA). Applicant argues that the Rule 132 declaration overcome the examiner's motivation to substitute the prior art's methyl with the instant butyl. Applicant argues that the Rule 132 Declaration demonstrates that the 90/10 MMA/AA is not suitable for use as nail enamel since it is too hard and prone to cracking and tearing. Applicant argues that the Rule 132 Declaration establishes that the instant BMA/AA is softer and not prone to cracking which makes it suitable for use in nail enamels. Therefore, applicant argues the claims are novel over the prior art.

Applicant's arguments filed 10/20/06 and 10/26/06 have been fully considered but they are not persuasive.

Firstly, the examiner notes that Perronin only exemplifies a MMA/AA copolymer and not the instant polymer. However, the examiner respectfully disagrees with applicant that Perronin does not suggest the use of butyl. Perronin suggests the use of several monomers including esters of methacrylic acids wherein the alkyl may be butyl. Thus, there is a clear suggestion for the substitution of the exemplified methyl with the instant butyl as the alkyl. The examiner points out "disclosed examples and preferred embodiments do not constitute a teaching away from the

Art Unit: 1616

broader disclosure or nonpreferred embodiment". In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

With regard to the Rule 132 Declaration, the Declaration under 37 CFR 1.132 filed 10/20/06 is insufficient to overcome the rejection of the claims based upon Perronin in view of Strella as set forth in the last Office action for the following reasons: The examiner notes that applicant has compared the prior art's 90/10 MMA/AA with the instant copolymer 90/10 BMA/AA and 95/5 BMA/AA. The examiner acknowledges that the Rule 132 Declaration establishes that the instant copolymers are softer and less prone to cracking than the prior arts. Thus, the instant copolymer wherein acrylic acid is in an amount of 5% and 10% respectively and butyl methacrylate is an amount of 90% and 95% respectively is unexpected. However, the examiner points out that the independent claim is directed to 2-14% acrylic acid. Meaning the butyl methacrylate may range from 86-98%. Applicant has not demonstrated that this unexpected property is applicable to the entire range claimed. For instance, applicant has only shown that the prior art's copolymer at 90 to 10 is hard and brittle but one cannot conclusively determine if this brittleness would occur at a different ratios such as, for instance, 14:86 or 2:98. It is unclear if the plasticity, i.e. the brittleness of the copolymers change with the concentration of the respective monomers. For instance, the examiner cannot determine that a ratio of 14:86 of a MMA/AA copolymer compared to a BMA/AA would still exhibit brittleness or both the copolymers would have the same plasticity. Secondly, it is noted that the claims are directed to the copolymer in an amount of 5-95% in the composition and the unexpected results show the unexpectedness of the copolymer in a weight percent of 3.7%, which is outside the range 5-95%. For instance, if the instant copolymer was utilized in a higher weight percent, would the composition as a whole still

Art Unit: 1616

be pliable and not prone to cracking? It cannot be conclusively determined if the composition as a whole would function in the same manner shown to be "unexpected" in the Declaration, i.e. softer and less prone to cracking, if the copolymer was utilized in the instant range of 5-95% (a higher weight percent) since the data in the Declaration only utilizes 3.7% of the copolymer. It is also noted that the prior art, Perronin, utilizes the copolymer in an amount of 13.7%. Therefore, applicant should make a comparison with the example that is closest to the instant invention.

Thus, the claimed ranges are not commensurate in scope with the unexpected results and therefore the Rule 132 Declaration is not sufficient to overcome the rejection.

Claims 61, 64, 66, 68, 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007).

Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersible of the pigment in a medium.. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, textiles, and cosmetics. Note column 1, lines 10-12. Perronin teaches the pigment composition may be advantageously used in numerous fields of application, such as the pigmentation of collodions for spinning, inks, plastics materials, paints, creams or other coloured preparations. See column 4, lines 45-55. Perronin teaches examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. see column 3, lines 40-60. Perronin teaches the pigments used in the composition may be mineral or organic pigments. Perronin teaches iron oxides, cadmium oranges, chrome yellows, molybdenum red and titanium dioxide as examples of mineral pigments. The organic pigments may belong to a variety of classes such

Art Unit: 1616

as azo, azomethine, anthraquinone, phthalocyanine or indigoids. See column 2, line 65 to column 3, line 5. The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, l-methyl-ethanol, n-butanol, 2-methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan. See column 2, lines 45-61.

Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% 90/10 copolymer of MMA-AA), 50% nitrocellulose resin in butyl acetate in 86 parts, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Note that nitrocellulose is in the amount of about 6.2% of the total composition; the pigment is in the amount of 13.7%, and the copolymer in the amount of 13.7%.

Although Perronin teaches that the monomers may be selected from several monomer including butyl and methyl esters of methacrylic acid, Perronin does not expressly teaches the instantly claimed butyl methacrylate-acrylic acid copolymer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look at the guidance provided by Perronin and utilize either methyl methacrylate or instant butyl methacrylate. One would have been motivated to do so since Perronin teaches

Art Unit: 1616

several monomers may be copolymerized such as esters of methacrylic acids including methyl and butyl. Thus a skilled artisan would have been motivated to substitute the exemplified methyl methacrylate with butyl methacrylate, i.e. substitute the exemplified methyl with butyl, since both are analogous compounds, i.e. both are alkyl esters of methacrylic acids. Therefore, absent unexpected results, substituting the prior art's methyl with instant butyl is deemed obvious to a skilled artisan.

With regard to the preamble, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With regard to the functional limitations, it is the examiner's position that Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar.

With regard to claim 82, Perronin teaches 6.2% nitrocellulose and not instantly claimed 0.5-5%. However, it would have been obvious to a skilled artisan to manipulate this concentration during routine optimization and experimentation. It should be noted that generally difference in concentrations do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such as concentration is critical. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to the copolymer molecular weight, the substitution of methyl for butyl will provide a molecular weight of about 68,000. The examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000.

Response to Arguments and Rule 132 Declaration

Applicant argues that Perronin et al discloses the use of a polymer comprising 90% methyl methacrylate (MMA/AA) and 10% acrylic acid and thus Perronin fails to suggest or teaches the instant butyl methacrylate/acrylic acid (BMA/AA). Applicant argues that the Rule 132 declaration overcome the examiner's motivation to substitute the prior art's methyl with the instant butyl. Applicant argues that the Rule 132 Declaration demonstrates that the 90/10 MMA/AA is not suitable for use as nail enamel since it is too hard and prone to cracking and tearing. Applicant argues that the Rule 132 Declaration establishes that the instant BMA/AA is softer and not prone to cracking which makes it suitable for use in nail enamels. Therefore, applicant argues the claims are novel over the prior art.

Applicant's arguments filed 10/20/06 and 10/26/06 have been fully considered but they are not persuasive.

Firstly, the examiner notes that Perronin only exemplifies a MMA/AA copolymer and not the instant polymer. However, the examiner respectfully disagrees with applicant that Perronin does not suggest the use of butyl. Perronin suggests the use of several monomers including esters of methacrylic acids wherein the alkyl may be butyl. Thus, there is a clear suggestion for the substitution of the exemplified methyl with the instant butyl. The examiner points out "disclosed examples and preferred embodiments do not constitute a teaching away from the broader disclosure or nonpreferred embodiment". In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Art Unit: 1616

With regard to the Rule 132 Declaration, the Declaration under 37 CFR 1.132 filed 10/20/06 is insufficient to overcome the rejection of the claims based upon Perronin as set forth in the last Office action for the following reasons: The examiner notes that applicant has compared the prior art's 90/10 MMA/AA with the instant copolymer 90/10 BMA/AA and 95/5 BMA/AA. The examiner acknowledges that the Rule 132 Declaration establishes that the instant copolymers are softer and less prone to cracking than the prior arts. Thus, the instant copolymer wherein acrylic acid is in an amount of 5% and 10% respectively and butyl methacrylate is an amount of 90% and 95% respectively is unexpected. However, the examiner points out that the independent claim is directed to 2-14% acrylic acid. Meaning the butyl methacrylate may range from 86-98%. Applicant has not demonstrated that this unexpected property is applicable to the entire range claimed. For instance, applicant has only shown that the prior art's copolymer at 90 to 10 is hard and brittle but one cannot conclusively determine if this brittleness would occur at a different ratios such as, for instance, 14:86 or 2:98. It is unclear if the plasticity, i.e. the brittleness of the copolymers change with the concentration of the respective monomers. For instance, the examiner cannot determine that a ratio of 14:86 of a MMA/AA copolymer compared to a BMA/AA would still exhibit brittleness or both the copolymers would have the same plasticity. Secondly, it is noted that the claims are directed to the copolymer in an amount of 5-95% in the composition and the unexpected results show the unexpectedness of the copolymer in a weight percent of 3.7%, which is outside the range 5-95%. For instance, if the instant copolymer was utilized in a higher weight percent, would the composition as a whole still be pliable and not prone to cracking? It cannot be conclusively determined if the composition as a whole would function in the same manner shown to be "unexpected" in the Declaration, i.e.

Art Unit: 1616

softer and less prone to cracking, if the copolymer was utilized in the instant range of 5-95% (a higher weight percent) since the data in the Declaration only utilizes 3.7% of the copolymer. It is also noted that the prior art, Perronin, utilizes the copolymer in an amount of 13.7%. Therefore, applicant should make a comparison with the example that is closest to the instant invention.

Thus, the claimed ranges are not commensurate in scope with the unexpected results and therefore the Rule 132 Declaration is not sufficient to overcome the rejection.

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) optionally in view of Strella (3,928,656) in view Katsen et al (5,746,817).

The teachings of Perronin have been delineated above. In particular Perronin teaches the preparation of pigment particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as paints, inks, plastics, and cosmetics. Note column 1, lines 10-12. Perronin teaches the use of dibutyl phthalate in the ink composition. Strella teaches the instant copolymer.

Perronin does not teach the instant plasticizer.

Katsen teaches an ink composition. Katsen teaches the use of plasticizers such as dibutyl phthalate and dipropylene glycol dibenzoate. See column 5, lines 30-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Perronin and Katsen and substitute Perronin's dibutyl phthalate with instantly claimed dipropylene glycol dibenzoate. One would have been motivated to do so since Katsen teaches both dibutyl phthalate and dipropylene glycol dibenzoate function as plasticizers. Therefore, a skilled artisan would have expected similar results since the prior art

Art Unit: 1616

teaches the functional equivalence of Perronin's dibutyl phthalate and instantly claimed dipropylene glycol dibenzoate.

Response to Arguments

Applicant's arguments filed 10/20/06 and 10/26/06 have been fully considered but they are not persuasive. It is noted that applicant has not addressed the instant rejection specifically. The arguments pertaining to Perronin by itself or in view of Strella and the Rule 132 Declaration has been the addressed above.

Claims 73 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) in view of Hosotte-Filbert et al et al (5,681,877) in further view of Pagano et al (5772988).

The teachings of Perronin have been set forth above. Perronin teaches the preparation of pigment particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The methacrylate-acrylic acid copolymer is 70-30. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% instant copolymer) with 86 parts nitrocellulose resin, 210 parts ethyl acetate, 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Suitable solvents include ethers and esters. See column 2, lines 60-62.

Perronin does not teach the use of a suspending agent or the instant plasticizer.

Hosotte-Filbert et al teach the use of block polymers, specifically as acrylic acid and methyl methacrylate, as dispersing agents of pigments in cosmetics. See abstract. The reference teaches a conventional base for nail varnish contains 10-15% nitrocellulose, 8-12% filler resin, 6-8% plasticizer (dibutyl phthalate), 65-75% solvents (ethyl acetate and butyl acetate), 0.8-1.5% suspending agent (bentone), and the pigment is added depending on the desired color. See example 9.

Pagano teaches a nail enamel composition containing pigments. Pagano teaches the use of suspension agents such as bentones, stearalkonium bentonite, hectorites, etc. in the amount of 0.1-15% as thickeners. See column 8, lines 1-25. Pagano utilizes plasticizers such as instant dipropylene glycol dibenzoate in the nail enamel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize conventional additives such as a suspending agents in a conventional varnish base. One would have been motivated to do so since Hosotte-Filbert teaches conventional nail varnish base contains plasticizers, suspending agents, solvents, resins, etc. Therefore, one would have been motivated to look to Hosotte-Filbert if one wanted to utilize Perronin's pigment in a nail composition. Further, one would expect similar results since Perronin teaches the pigmented composition may be used in cosmetics and color compositions.

Furthermore, one would have been motivated to look to the teachings of Pagano and utilize the instantly claimed suspending agent and plasticizer since Pagano demonstrates the state of the art wherein instantly claimed additives are known in the nail art. A skilled artisan would have been motivated to utilize the instant suspending agent since Pagano teaches that Hosotte-

Art Unit: 1616

Filbert suspending agent (bentone) and the instant suspending agents are functional equivalents.

Therefore, a skilled artisan would have expected similar results the instant suspending agent.

Response to Arguments

Applicant's arguments filed 10/20/06 and 10/26/06 have been fully considered but they are not persuasive. It is noted that applicant has not addressed the instant rejection specifically. The arguments pertaining to Perronin by itself or in view of Strella and the Rule 132 Declaration has been the addressed above.

Conclusion

All the claims are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sharmila S. Gollamudi
Examiner
Art Unit 1616